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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,425	09/27/2001	Rui Saito	214375US0	8762

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/963,425	SAITO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Judy M. Reddick	1713	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 5) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 6) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1713

**DETAILED ACTION**

**Priority**

1. ***Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.***

**Claim Rejections - 35 USC § 112**

2. ***The following is a quotation of the first paragraph of 35 U.S.C. 112:***

***The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.***

3. ***Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific radiation resistant compounds which include rosin, rosin derivatives such as hydrogenated rosin, disproportionated rosin, polymerized rosin, etc., terpene resin, hydrogenated terpene resin, etc, does not reasonably provide enablement for compounds falling within the broad scope of "radiation-resistant agent", as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.***

**Claim Rejections - 35 USC § 102**

4. ***The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:***

***A person shall be entitled to a patent unless –***

***(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.***

**5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

**6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 09316417(Abstract), JP 40814384(Abstract) or JP 408041434(Abstract).**

***JP'417 teaches an acrylic adhesive composition and a tape therefrom wherein said adhesive composition is defined basically as containing (i) an acrylic copolymer and (ii) a tackifying resin(sufficient to meet the radiation-resistant agent, as claimed).***

***JP'847 teaches an acrylic adhesive composition and an article therefrom wherein said adhesive composition is defined basically as containing an acrylic copolymer, a tackifier resin(sufficient to meet the claimed radiation-resistant agent) and a polyisocyanate.***

***JP'434 teaches an acrylic adhesive composition defined basically as containing 100 pbw of an acrylic copolymer, 1-20 pbw of a 2-12C low molecular weight compound or 5-20 pbw of a tackifying resin having at least one carboxyl groups(sufficient to meet the claimed radiation-resistant agent) and 0.05-3 pbw of a multifunctional carbodiimide compound.***

**See the Abstracts of each of patentees. Each of JP'417, JP'847 and JP'434 therefore anticipate the instantly claimed invention.**

**While each of patentees are silent with respect to the property limitations, as claimed, it would be expected that the adhesive compositions and articles therefrom of each of JP'417, JP'847 and JP'434 would possess the claimed properties since the compositions of each of JP'417, JP'847 and JP'434 are essentially the same as and made in essentially the same manner as the claimed acrylic adhesive composition and in the absence of the USPTO to have at its disposal the tools deemed necessary to make physical determinations of this sort. Applicant has the burden to show that this, in fact, is not the case as provided for under the auspices of *In re Best et al*(195 USPQ 430) and/or *In re Fitzgerald et al*(205 USPQ 594).**

**Claim Rejections - 35 USC § 102**

**7. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hagiwara et al(U.S. 4,373,046), Iwata et al(U.S. 4,400,486), Traynor et al(U.S. 4,726,982), Lin et al(U.S. 5,045,396), Miyajima et al(U.S. 5,229,447), Gotoh et al(U.S. 5,232,787), Sawamoto et al(U.S. 5,318,835) or Yanagi et al(U.S. 5,596,028).**

**Hagiwara et al teach an exemplify a radiation-resistant acrylic polymer composition and sheet therefrom wherein said composition is defined basically as containing a polymer which includes an acrylic resin, 5 to 150 pbw per 100 pbw of polymer of a halogenated acenaphthylene condensate(sufficient to meet the radiation-resistant agent per the claims) and other conventional adjuncts which include an agent for providing radiation resistance, light stabilizer, etc. See the**

**Abstract, cols. 3-4, Runs (with the understanding that one of ordinary skill in the art would have readily envisioned the use of the equivalently taught acrylic resin in lieu of the exemplified resins) and the claims of Hagiwara et al.**

**Iwata et al teach and exemplify an acrylic adhesive composition, in the production of tapes, stickers, sheets, etc., defined basically as containing an 100 pbw of an acrylic polymer and 5 to 100 pbw of a modified cyclopentadiene resin or its hydrogenation product, as a tackifier and sufficient to meet the radiation-resistant agent per the claimed invention. See, the Abstract, cols. 1-4 (examples inclusive) and the claims of Iwata et al.**

**Traynor et al disclose and exemplify pressure sensitive adhesive compositions and a composite tape therefrom wherein said composition is defined basically as containing a x-linked acrylic copolymer and 5-50 pbw of a tackifier resin (sufficient to meet the claimed radiation-resistant agent). See, e.g., the Abstract, Runs 1-12 and the claims of Traynor et al.**

**Lin et al disclose and exemplify an ultraviolet radiation resistant primer composition and a plastic substrate coated with said composition and wherein said composition is defined basically as containing a blend of an acrylic polymer, a UV absorber, a solvent and a flow control additive (sufficient to meet the claimed radiation-resistant agent). See the Abstract, cols. 2-4, Runs I and II and the claims.**

**Miyajima et al teach and exemplify pressure sensitive adhesive compositions useful in the production of tapes, tack papers, etc. and defined basically as containing 100 pbw of an acrylic polymer, 50 to 500 pbw of a surface active agent (sufficient to meet the claimed radiation-resistant agent), 0.01 to 5 pbw of**

*cross-linking agent(s) and a tackifier(sufficient to meet the claimed radiation-resistant agent. See, the Abstract, cols. 2-4, the Runs and claims of Miyajima et al. Gotoh et al disclose and exemplify pressure sensitive adhesive compositions and the use of such in producing adhesive tapes wherein said adhesive compositions are defined basically as containing an acrylic resin, a tackifying resin(sufficient to meet the claimed radiation-resistant agent) and other conventional adjuncts such as uv absorber, pigment, light stabilizer, etc. See, the Abstract, col. 3 and the Runs of Gotoh et al.*

*Sawamoto et al disclose and exemplify pressure sensitive adhesive compositions and tapes there from wherein said adhesive composition is defined basically as containing an acrylic copolymer, 1-50 pbw of a polymer having a hydrolysable silicon-containing radical, 0.1 to 5 pbw of a polyfunctional isocyanate and less than or equal to 100 pbw of a tackifier resin(sufficient to meet the claimed radiation-resistant agent per the claimed invention). See, e.g., the Abstract, cols. 2-6, the Runs and claims of Sawamoto et al.*

*Yanagi et al disclose and exemplify an anaerobic adhesive composition and a sheet or tape there from, wherein said adhesive composition is defined basically as containing a rubber-based resin which includes an adhesive acryl polymer, 30 to 150 pbw of a compound which includes rosin and derivatives thereof, terpene resins and derivatives thereof(sufficient to meet the claimed radiation-resistant agent), an ethylenically unsaturated monomer, 0.05 to 2.0 pbw of a polyisocyanate, 0.05 to 2.0 pbw of a polyepoxy compound and other conventional adjuncts which include a pigment, tackifier, coupling agent, etc. See, e.g., the*

**Abstract, cols. 4-9, the Runs(Inventive and Comparative) and the claims of Yanagi et al.**

**Each of patentees therefore anticipate the instantly claimed invention. The claimed property limitations, if not taught, would be expected to be possessed by the adhesive compositions and articles therefrom of patentees since the adhesive compositions of each of patentees are essentially the same as and made in essentially the same manner as the claimed adhesive compositions. Reference In re Best et al(195 USPQ 430) and/or In re Fitzgerald et al(205 USPQ 594).**

**Claim Rejections - 35 USC § 102**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

**The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).**

**8. Claims 1-5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murakami et al et al(U.S. 5,998,018), Arakawa et al(U.S. 6,120,866) or Hosokawa et al(U.S. 6,312,799).**

**Murakami et al disclose and exemplify masking tape having a cross-linked acrylic pressure sensitive adhesive layer formed thereon wherein said acrylic adhesive comprises a composition defined basically as containing an acrylic polymer, 0.01 to 10 pbw of a x-linking agent and 0.1 to 15 pbw of a chlorinated polypropylene**



*resin(sufficient to meet the claimed radiation-resistant agent). See, e.g., the Abstract, cols. 4-7 and Runs 9 and 10 of Murakami et al.*

*Arakawa et al* disclose and exemplify pressure sensitive adhesives and adhesive tapes therefrom and wherein the pressure sensitive is defined basically as containing an acrylic resin, 20 to 200 pbw of a tackiness-imparting resin(sufficient to meet the claimed radiation-resistant agent) and other conventional adjuvants which include a softener, a coloring agent, a filler, etc. See, e.g., the Abstract. Cols. 8 and 9, Run 2-1 and the claims of Arakawa et al.

*Hosokawa et al* disclose and exemplify pressure sensitive acrylic adhesive compositions and sheets therefrom wherein said adhesive composition is defined basically as containing an acrylic copolymer and less than or equal to 30 pbw of other additives such as tackifiers, plasticizers, x-linking agent, etc. See, e.g., the Abstract, cols. 1-4, Run 1 and Comparative Run 3(although in the form of a negative teaching, it is nonetheless taught).

Each of Murakami et al, Arakawa et al and Hosokawa et al therefore anticipate the instantly claimed invention. The claimed property limitations, if not taught, would be expected to be possessed by the compositions and articles therefrom of each of patentees since the compositions are essentially the same as and made in essentially the same manner as the claimed acrylic adhesive composition.

Consult *In re Best et al*(195 USPQ 430) and/or *In re Fitzgerald et al*(205 USPQ 594).

#### **Conclusion**

9. The additional prior art made of record and not relied upon is cited as of interest in teaching acrylic adhesive compositions similar to the claimed acrylic adhesive

*composition and considered merely cumulative to the prior art supra. A future rejection may be made based on the disclosures of the additional prior art.*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

*J. M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
August 30, 2002